

REMARKS

Claims 1-20 are pending in this application. By this Amendment, claim 1 is amended.

Claims 15-20 are added. No new matter is added.

I. Election of Species

Applicants again respectfully traverse the Election of Species Requirement regarding claims 1-14. As each of the originally filed claims depended from independent claim 1, it is clear that a search for a subject matter of any one of the species would encompass a search for the subject matter of each of the remaining species. Moreover, upon allowance of any of generic claims 1-6, 9, 10 or 12, consideration and allowance of the claims pertaining to the remaining, unelected species, is respectfully requested.

II. Information Disclosure Statement

Applicants respectfully request acknowledgement of receipt and consideration of the references cited in the Information Disclosure Statement submitted on January 5, 2006.

III. Claim Rejections Under 35 U.S.C. §102

Claims 1-4 are rejected under 35 U.S.C. §102(b) as anticipated by U.S. Patent No. 4,825,723 to Martin. The rejection is respectfully traversed.

Martin fails to disclose each and every feature recited in the rejected claims as amended. For example, Martin fails to disclose a starter comprising a planetary reduction gear device has a planet carrier that has a first surface and a second surface opposite to each other and forms shafts projecting from a first surface and a plurality of planetary gears supported by the gear shafts, the planet carrier further forming projections projecting from the first surface in a direction same as that of the gear shafts, and the projections and the gear shafts are integrally formed with the planet carrier.

Martin relates to a planetary gear train used for an aircraft flap actuator or a deployment of folded helicopter rotor blades. Therefore, Martin fails to relate to or disclose a

starter as recited in the pending claims. It is alleged in the Office Action that the projections described in Martin which support planetary star gears correspond to the projections recited in the rejected claims.

The "projections" disclosed in Martin do not correspond to the projections recited in the rejected claims, as amended. As clearly described in the specification and shown in Figs. 1 and 2 of Martin, the drive shaft 74 is meshed with radially arranged pairs of star gears 78 and 80 that are carried by the flange 56 on a sleeve member 54. The outer star gear 80 of each set is meshed with an outer drive ring 82 which is meshed with and transmits rotary motion to the sun gear 16 (col. 6, lines 13-27). Thus, as recited in the specification and shown in the figures, each of the projections carries a star gear. In contrast, the rejected claims recite gear shafts that support planetary gears and projections that project from the planet carrier in the same direction as the gear shafts. In other words, the gear shafts and projections are structurally distinct members. Further, each of the gear shafts and the projections extend from and are integrally formed with, the surface of the planet carrier.

Also, as clearly shown in Fig. 1 of Martin, the alleged projections which carry the star gear 78 and 80 pass through the flange. Moreover, Martin only discloses gear shafts and fails to disclose any other corresponding structure extending from the surface of the flange 56. Regardless of how broadly the projections are being interpreted, the projections cannot be interpreted so broadly as to correspond to both gear shafts and separate projections that are structurally distinct items. Accordingly, Martin fails to disclose each and every feature recited in the rejected claims, as amended.

IV. Claim Rejections Under 35 U.S.C. §103

Claim 5 is rejected under 35 U.S.C. §103(a) as unpatentable over Martin in view of U.S. Patent No. 4,249,964 to Bambuch et al. (hereinafter "Bambuch").

Claim 5 is allowable for at least its dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Further, because Bambuch fails to relate in any way to a starter motor, or disclose or suggest any of the features recited in such a starter motor, the additional reference of Bambuch fails to overcome the deficiencies of the primary reference. Accordingly, withdrawal of the rejection of claim 5 under 35 U.S.C. §103(a) is respectfully requested.

Claims 9 and 10 are rejected under 35 U.S.C. §103(a) as unpatentable of Martin in view of U.S. Patent No. 5,609,542 to Kusumoto et al. (hereinafter "Kusumoto"). The rejection is respectfully traversed.

Neither Martin nor Kusumoto, whether considered alone or in combination, disclose or suggest each and every feature recited in the rejected claims. Moreover, claims 9 and 10 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Finally, because Kusumoto fails to overcome any of the deficiencies regarding the rejection of independent claim 1, the combination of references fails to render claims 9 and 10 obvious. Therefore, withdrawal of the rejection of claims 9 and 10 under 35 U.S.C. §103(a) is respectfully requested.

Claims 1-4, 7, 8, 13 and 14 are rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 5,115,689 to Isozumi et al. (hereinafter "Isozumi") in view of U.S. Patent No. 3,527,121 to Moore. The rejection is respectfully traversed.

Neither Isozumi nor Moore, whether considered alone or in combination, disclose or suggest each and every feature recited in the rejected claims as amended. For example, the combination of references fails to disclose or suggest a starter comprising . . . a planetary reduction gear device has a planet carrier that has a first surface and a second surface opposite to each other and forms shafts projecting from a first surface and a plurality of planetary gears supported by the gear shafts, the planet carrier further forming projections projecting from

the first surface in a direction same as that of the gear shafts, and the projections and the gear shafts are integrally formed with the planet carrier.

It is admitted in the Office Action that Isozumi fails to disclose each and every feature recited in the rejected claims. For example, it is admitted that the Isozumi patent "lacks the teaching of the planet carrier further forming projections projecting in a same direction as that of the gear shafts." In an effort to overcome the admitted deficiency, Moore is combined for allegedly teaching such projections.

The primary reference of Isozumi relates to a starter unit for an automobile. The problem being addressed in Isozumi is the problems caused by excessively large loads during start-up, especially to the ring gear so that the pinion 11 and other components are damaged (col. 2, lines 7-27). It is alleged in the Office Action that it would have been obvious to modify the automobile starter of Isozumi with the teachings of Moore. However, Moore relates to an automobile transmission which seeks to increase the transmission of higher torque by increasing the number of larger diameter pinion gears for a minimum diameter carrier (col. 1, lines 28-49).

Applicants submit there is no motivation or suggestion to modify an automobile starter motor with the teachings of a transmission. To establish a *prima facie* case of obviousness, there must be some suggestion and motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine the reference teachings. In this case, it is suggested in the Office Action to modify the starter motor of Isozumi with the teachings of the automobile transmission of Moore. However, there is no such motivation or suggestion because the disclosures of the references relate to a problems different from that of this specification. If a reference's disclosure relates the same problem as the claimed invention, that fact supports the use of the reference in an obviousness rejection (*In re Clay*, 956 F.2d, 656, 659)

(Fed. Cir. 1992). Because neither of the applied references relate to the same problem being addressed in this application, there is no motivation or suggest in the references to make the combination.

Additionally, the teaching or suggestion to make a claim combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure (see MPEP §2143). When making an assessment of the differences between the prior art and the claimed subject matter, §103 specifically requires consideration of the claimed invention as a whole. The "as a whole" instruction prevents evaluation of the invention on a part-by-part basis. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a road map to find its prior art components. *In re Ruiz v. Chance Co.*, 357 F.2d 1270, 1275 (Fed. Cir. 2004). Because the teachings of an automobile starter are being combined with an automobile transmission, the references are not being considered "as a whole". Rather, the invention is being broken into component parts and any reference purportedly disclosing an otherwise missing element is being combined. As there is no motivation nor suggestion in either of the references to make the combination as alleged in the Office Action, it appears the improper use of hindsight is being relied upon in an effort render the subject matter of the claims obvious.

Moreover, even were such a combination made, the resulting combination of references still fails to disclose or suggest each and every feature recited in the rejected claims, as amended. For example, it is alleged in the Office Action that the automobile transmission of Moore discloses both gear shafts and projections, i.e., the long pinion pins 48 and short pinion pins 58. However, as each of these pinion pins clearly are gear shafts, as each of the pinion pins holds a pinion gears. Thus, neither of the pinion pins corresponds to the projections in the

recited claims. Accordingly, withdrawal of the rejection of claims 1-4, 7, 8, 13 and 14 under 35 U.S.C. §103(a) is respectfully requested.

Claim 5 is rejected under 35 U.S.C. §103(a) as unpatentable over Isozumi in view of Moore and further in view of Bambuch; and claims 9 and 10 are rejected under 35 U.S.C. §103(a) as unpatentable over Isozumi and Moore and further in view of U.S. Patent No. 5,609,542 to Kusumoto. The rejections are respectfully traversed.

Claims 5, 9 and 10 are allowable for their dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein. Further, as neither Bambuch nor Kusumoto overcome the deficiencies of Isozumi and Moore, the combination of references fails to render obvious the subject matter of claims 5, 9 and 10. Accordingly, withdrawal of the rejection of claims 5, 9 and 10 under 35 U.S.C. §103(a) is respectfully requested.

V. New Claims

None of the applied references, whether considered alone or in combination, disclose or suggest each and every feature recited in claims 15-20. For example, the combination of references fails to disclose or suggest the starter according to claim 1, wherein only the gear shafts support the planetary gears or the starter according to claim 1, wherein each of the gear shafts and the projection has an outer wall continuous from the first surface of the planet carrier.

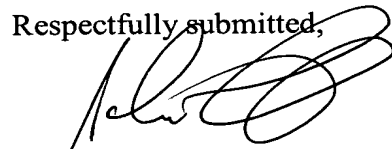
Additionally, claim 19 recites the subject matter of allowable claim 6 and original claim 1. Thus, claim 19 is in condition for allowance. Further, as claim 20 depends from allowable claim 19, claim 20 is also in condition for allowance.

VI. Conclusion

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-20 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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